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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,450	10/29/2003	Alex Kunzler	31132.165	5975

46333 7590 01/30/2007  
HAYNES AND BOONE, LLP  
901 MAIN ST  
SUITE 3100  
DALLAS, TX 75202

EXAMINER
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SWIGER III, JAMES L

ART UNIT	PAPER NUMBER
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3733

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/696,450

Applicant(s)

KUNZLER, ALEX

Examiner

James L. Swiger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 21,22,25-30,34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,23,24 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/29/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/10/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietz et al. (US 5,653,714). Dietz et al. disclose a device to cut and prepare bone having a guide body (10), a bone removal device (6) having a longitudinal axis between its own proximal and distal portion (at 6 end), a pair of guide members (32), an alignment device movably engaged between guide body and device, and where the bone removal device is capable of being moved along a predefined pattern along the guide members in use. Dietz et al. also disclose that the guide members are rotatably, or pivotally connected to the bone removal device (via the projection to pivot, 36) where the guide members may also be considered rotationally connected. These pivots are also considered projections, and although only one is shown in Fig. 5, there would have to be a second one present, since in Fig. 5 only a cut away portion of the full device is shown. Also, the two guide members may be considered eccentric, as by means that their center points can vary as they are rotated or moved relative to the guide body and bone removal device.

With regards to the bone milling pattern, the device is capable of producing a

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pattern either circular in shape or toroidal (donut-shaped) by the movement along the guide members if one wishes to do so. Further the guide members each have a major side surface (see profile in Fig. 3 of 32) and wherein the predetermined pattern may be in a plane substantially parallel to the longitudinal axis (in the direction of the guide members), depending on how one looks at the device. The device may be considered to be housed in a "cage" (12) and has a connecting rod (42). The device also has an inner surface with a track (16) that enables the guide members to control said bone removal device. The bone prep device is also considered to have a bone removal element (the serrations of 6, see Fig. 7) that has an axis of rotation that may be considered offset with respect to the longitudinal axis. This axis may be considered substantially transverse depending on how it is oriented, therefore being capable of a non-linear predetermined pattern. The alignment device is also capable of controlling the speed and direction of its guide members, depending on how it is used.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, 17-18, 20, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz et al. '714 in view of Zarnowski et al. (US Patent 4,892,093).

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Dietz et al. disclose the claimed invention except for the guide members being substantially aligned along an alignment axis substantially parallel to the axis of the bone removal device. Zarnowski et al. disclose a device wherein a bone removal device (50) can slide and tilt along the guide area created by (34). As the cutting device may slant and angle towards one corner of the guide area, its axis is then substantially aligned with that of the guide device. See Col. 4, lines 9-39. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Dietz et al. having at least its guide members being substantially aligned along an alignment axis substantially parallel to the axis of the bone removal device in view of Zarnowski et al. to better align the device and cut the bone area

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dietz et al. (US Patent 5,653,714) and Zarnowski et al. '093 as applied to claim 1 above, and further in view of Michelson (US Patent 6,537,279). The combination of Dietz et al. and Zarnowski et al. disclose the claimed invention except for the bone removal device being coupled to a power source. Michelson discloses a preparation device that is connected to a power source to help drive the device in use. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Dietz et al. and Zarnowski et al. having at least a power source (Col. 5, lines 1-14) to better use the device.

Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dietz et al. '714 and Zarnowski et al. '093 as applied to claim 1 above, and further in view of Morrison (US Patent 3,978,862). The combination of Dietz et al.

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and Zarnowski et al. disclose the claimed invention except for a gear. Morrison discloses a cutting device that has a gear (37) to aid in driving the cutter portion of the bone alignment device (Col. 3, lines 40-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Dietz et al. and Zarnowski et al. having at least a gear in view of Morrison to better operate the device to move the cutter in use.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz et al. '714 in view of Morrison (US Patent 3,978,862). Dietz et al. disclose the claimed invention except for a gear. Morrison discloses a cutting device that has a gear (37) to aid in driving the cutter portion of the bone alignment device (Col. 3, lines 40-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Dietz et al. having at least a gear in view of Morrison to better operate the device to move the cutter in use.

### ***Response to Arguments***

Applicant's arguments filed 11/21/2006 have been fully considered but they are not persuasive. With regards to the arguments regarding the eccentric guides, the two guide members may be considered eccentric, as by means that their center points can vary as they are rotated or moved relative to the guide body and bone removal device.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

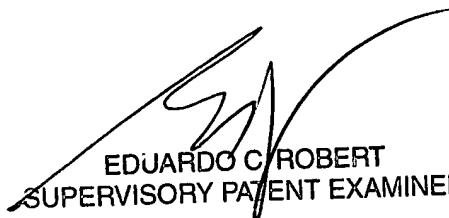
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS 1/24/07

JLS

  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER